

REMARKS:

Claims 1-10 and 12-14 are pending and stand rejected.

The single issue remaining in this case is: Can a foreign equivalent of a properly terminally-disclaimed US patent be cited as a valid 35 U.S.C. §103(a) reference?

Applicant has found no case law directly on this point, nor any specific reference to this point in the Patent Laws of 35 U.S.C. or the Patent Rules of 37 C.F.R., and can argue only public policy, the purpose of the Terminal Disclaimer, and the negative effect of such a new policy.

Should Applicant's terminal disclaimer, of record in the present application, be sufficient to eliminate also the foreign equivalents of said disclaimed US patent, then the Roberts et al (EP 1136536) reference is no longer an effective 35 U.S.C. 103(a) reference, making the present rejection moot, and the claims as they currently stand allowable.

Applicant believes that the Examiner may not be able to make this type of determination, and perhaps the issue can only be handled on Appeal or in the courts.

Facts

French patent application FR 0003797 was filed on March 24, 2000 by Atofina (Akema's predecessor) and owned 100 percent by Applicant. From this application, European and US applications were filed, claiming priority to FR 0003797 under the Paris Convention:

- a) EP 1,136,536 B1, filed March 16, 2001, and published September 26, 2001
- b) US 6,528,587 B2, filed March 26, 2001 (first business day – Monday – after the 1-year anniversary of the priority document), and published December 20, 2001.

The present patent application was filed in the US on September 26, 2003, claiming Priority to FR 02 11992, filed September 27, 2002.

In response to a non-statutory double patenting rejection by the Examiner in the present application, Applicant filed a Terminal Disclaimer on April 29, 2005 over US 6,528,587 B2.

The Examiner recognizes the equivalence of the EP 1,136,536 and US 6,528,587 patents, as the Examiner uses the US '587 as a translation of EP '536.

Applicant does not disagree with the Examiner, that the EP 1,136,536 fits the definition of a 35 U.S.C. §103(a) reference, at least in regards to using the filing date as a surrogate for an invention date, since the EP 1,136,536 reference was published (9/26/2001) prior to filing of the present application (9/26/2003) and prior to the priority date (9/27/2002) claimed in the present invention.


Applicant maintains, however, that the Examiner's application of 35 U.S.C. §103(a) to a foreign equivalent of a US case that is the subject of a terminal disclaimer is improper on the basis of public policy, and the purpose of terminal disclaimer as a response to a non-statutory non-obvious-type rejection..

- 1) The Examiner is creating new law which in effect limits the use of a terminal disclaimer only to US cases filed less than 18 months prior to a application at issue in US cases that were also foreign filed. Since foreign cases publish at 18 months, disclaimer of any US patent older than 18 months would be worthless – as the foreign equivalent could then be cited as 35 U.S.C. §103(a) prior art instead of the disclaimed US patent.
- 2) The use of a terminal disclaimer in overcoming a nonstatutory double patenting rejection is in the public interest because it encourages the disclosure of additional developments, the earlier filing of applications, and the earlier expiration of patents whereby the inventions covered become freely available to the public. MPEP 804.02(II). *In re Jentoft*, 392 F.2d 633, 157 USPQ 363 (CCPA 1968); *In re Eckel*, 393 F.2d 848, 157 USPQ 415 (CCPA 1968); and *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967).
- 3) If a terminal disclaimer over a US patent is not also a terminal disclaimer over all foreign equivalent cases having the same priority date, then the terminal disclaimer ceases to function in the manner anticipated in the law. The main function of the Terminal Disclaimer is that it obviates the primary objection to double patenting, which is the extension of monopoly. *In re Robeson*, 331 F.2d 610, 141 USPQ 485 (1964). The Terminal Disclaimer accepted in the present application serves this function. There are many statements of the advantages of the Terminal Disclaimer to public policy, as improvements are placed into the public domain. In this regard, the framers of the present regulations placed no limits on length of time that can be terminally disclaimed.

The double patenting rejection has been obviated with respect to the invention described in the US 6,528,587 patent. That invention is identical to the French-described invention in the EP '536 patent since both patents originated from the same priority document. The terminal disclaimer places the present claims in the same position with respect to the EP'536 subject matter as the US '587. Since the present claims now terminate with the US'587 patent claims there is no monopoly extension over either US '587 or the equivalent EP '536.

In view of the above, the Applicant believes that the reasons for rejection have been overcome, and the claims herein should be allowable to the Applicant. Accordingly, reconsideration and allowance are requested.

Respectfully submitted;



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